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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,632	11/15/2001	Sumio Nishiyama	Q66942	7412

7590 09/14/2006

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EXAMINER

BENGZON, GREG C

ART UNIT PAPER NUMBER

2144

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,632

Applicant(s)

NISHIYAMA, SUMIO

Examiner

Greg Bengzon

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This application has been examined. Claims 1-12 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/27/2006 has been entered.

Priority

This application claims benefits of priority from Foreign Application (Japan) P2000-349470 filed November 16, 2000.

The effective date of the claims described in this application is November 16, 2000.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites a limitation 'wherein the plurality of data files do not overlap with each other'. Though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

The Applicant presented Applicant Specifications (Fig. 3; page 15, lines 12-22; page 21, line 24, to page 22, line 4) and (Fig. 3; page 15, line 23, to page 17, line 6) in support of the claim limitations.

The Examiner notes that specification was not enabling with respect to the said claims at issue, noting further that there was no considerable direction and guidance in the specification; that there was no evidence presented by the Applicant of a high level

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of skill in the art at the time the application was filed; and also no evidence presented that all of the methods needed to practice the invention were well known.

Regarding the cited portions of the Applicant Specifications, the Examiner notes that cited portions only describe the contents of each node data and do not address issue of overlapping data.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby et al. (EP 0943895) in view of Tagi (US Patent 6473790) further in view of Carroll (US Patent 6421610).

Ashby disclosed (re. Claim 1) a plurality of data files structured individually by dividing distributed data (Ashby Paragraph 53) , wherein each of the data files is

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classified by type of each data file and is further classified by function (Ashby-Paragraph 74-75) of each data file, and data distribution means for selecting, from among the plurality of data files, only data files that are necessary to constitute the distributed data, (Paragraph 55) combining the selected data files into distributed data, and distributing the distributed data.

However Ashby did not explicitly disclose the term distribution server and wherein the plurality of data files do not overlap with each other.

Tagi disclosed a distribution server (Tagi-Column 1 Lines 6-9, Column 2 Lines 57 thru Column 3 Lines 63).

Ashby and Tagi are analogous art because they present concepts and practices regarding the distribution of data to mobile terminal apparatus. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Tagi into Ashby. The motivation for said combination would have been to help the user for navigating an unfamiliar building or territory. (Tagi-Column 1 Lines 24-31)

Carroll disclosed generating a nearly seamless mosaiced image covering the entire area of interest, such that the plurality of data files do not overlap with each other. There is neither overlap from one cell to an adjacent cell, nor is there any portion of the

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entire geospatial image which is omitted when adjacent cells are viewed together.

(Carroll-Column 5 Lines 20-25)

Ashby, Tagi, and Carroll are analogous art because they present concepts and practices regarding the distribution of data to mobile terminal apparatus. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Carroll into Ashby-Tagi. The motivation for said combination would have been to provide seamless transition from one sector to another. (Carroll- Column 3 Lines 35-40)

Ashby-Tagi-Carroll disclosed (re. Claim 2) wherein the data distribution means responds to a formation condition set at a terminal to receive data distribution from said data distribution server and selects data files fitted for the formation condition from among the plurality of data files. (Ashby-Paragraph 55 thru Paragraph 57)

Ashby-Tagi-Carroll disclosed (re. Claim 3) wherein identification codes by function are assigned to the plurality of data files and any desired identification code is specified at the terminal, whereby the formation condition of the distributed data is set. (Ashby-Paragraph 56)

Ashby-Tagi-Carroll disclosed (re. Claim 4) wherein the data files are files of data by function into which data concerning a map is divided by navigation function. (Ashby-Paragraph 55)

Ashby-Tagi-Carroll disclosed (re. Claim 5) wherein a required function for navigation is specified at a navigation system of a terminal to set the formation condition of the distributed data. (Ashby-Paragraph 55)

Ashby-Tagi-Carroll disclosed (re. Claim 6) wherein the data files are files of data by function of at least a display function, a locating function, a search function, and a route calculation function. (Ashby-abstract)

Ashby-Tagi-Carroll disclosed (re. Claim 7) wherein the data files are files of data by function of at least a display function, a locating function, a search function, and a route calculation function. (Ashby-Paragraph 39)

Claims 8-12 are rejected on the same basis as Claims 1-7.

Response to Arguments

Applicant's arguments filed 06/27/2006 have been fully considered but they are not persuasive.

However, in order to expedite prosecution, new grounds for rejection are presented, incorporating prior art regarding 'plurality of data files do not overlap with each other'.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

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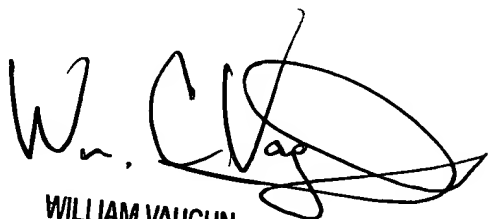
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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